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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,362	11/07/2000	David J. Luman	10003281-1	1647

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EXAMINER

NGUYEN, FRANCIS N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 04/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/708,362

Applicant(s)

LUMAN ET AL.

Examiner

FRANCIS NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/14/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 16, 17, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 10-12, 15 and 18 is/are rejected.
- 7) ☐ Claim(s) 2, 6, 8, 9, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on 1/14/2003 is entered.

### *Specification*

2. The disclosure is objected to because of the following informalities: missing information of related applications ( page 1, lines 9-19).

Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3-5, 7, 10-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-5, 10, 12-13 of U.S. Patent No.

6,396,525 in view of US Patent Eberhard et al. ( US Patent 6,331,867).

Claim 1 differs from claim 1 of US Patent 6,396,525 in limitation "control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device".

Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll

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buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 3 differs from claim 3 of US Patent 6,396,525 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”.

Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 4 differs from claim 4 of US Patent 6,396,525 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”.

Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 5 differs from claim 5 of US Patent 6,396,525 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”.

Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the

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art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 7 differs from claim 10 of US Patent 6,396,525 in limitation "control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device".

Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 10 differs from claim 12 of US Patent 6,396,525 in limitation "control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device". Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 11 differs from claim 13 of US Patent 6,396,525 in limitation "control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device". Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Johnson ( Patent 6,396,525) then

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add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

5. Claims 12, 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 17 of U.S. Patent No. 6,542,176 in view of US Patent Eberhard et al. ( US Patent 6,331,867).

Claim 12 differs from claim 8 of US Patent 6,542,176 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”. Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Camis ( Patent 6,542,176) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

Claim 15 differs from claim 17 of US Patent 6,542,176 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”. Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Camis ( Patent 6,542,176) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

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6. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 29 of U.S. Patent No. 6,448,990 in view of US Patent Eberhard et al. ( US Patent 6,331,867)

Claim 18 differs from claim 29 of US Patent 6,448,990 in limitation “control area on the housing comprising one or more user-engagable structures to permit a user to interact with the device”. Eberhard et al. teaches a control area on the housing , ON/OFF button 36, UP/DOWN scroll buttons ( column 3, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the apparatus of Camis et al. ( Patent 6,448,990) then add a control area with buttons, as taught by Eberhard et al., to the housing of the electronic device because it would allow a user to operate the electronic device with ease.

***Allowable Subject Matter***

7. Claims 16, 17, 19 and 20 are allowed.

8. Claims 2,6, 8-9, 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 3-5, 7, 10-12, 15, 18 have been considered but are moot in view of the new ground(s) of rejection.

**CONCLUSION**

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FRANCIS N NGUYEN** whose telephone number is **703 308-8858**. The examiner can normally be reached during hours 8:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **RICHARD A HJERPE** can be reached at 703 305-4079.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks


Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 ( for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor ( Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service whose telephone number is (703) 306-0377.



April 21st, 2003

FRANCIS N NGUYEN  
Examiner  
Art Unit 2674